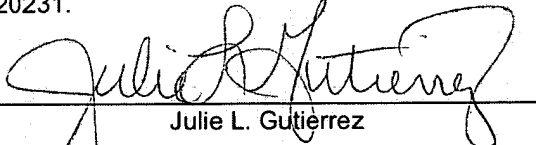


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Julie L. Gutierrez



Atty. Docket No. 31045-00007

PATENT

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#11  
Reply  
Brief  
E. Gutierrez  
1/12/01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

ALBERT J. SILVERA

Serial No.: 09/268,412

Filed: March 15, 1999

For: TECHNIQUE FOR DECORATING A  
SHOE AND A SHOE DECORATED  
USING THE TECHNIQUE

Group Art Unit: 3728

Examiner: J. Mohandesi

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JAN 11 2001  
TC 3700 MAIL ROOM

**APPELLANT'S REPLY BRIEF  
ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Appellant in the above-captioned patent application makes the following reply to the Examiner's Answer mailed November 3, 2000.

The Examiner's Answer mainly repeats arguments made by the Examiner in the Office Action dated April 13, 2000. In response to those arguments, Appellant filed an Appeal Brief on October 11, 2000. That Appeal Brief provided detailed reasons as to why each of the seven different groups of claims is believed to be allowable over the applied art. Moreover, those reasons fully addressed the Examiner's grounds for rejection set forth in the April 13, 2000 Office Action.

However, the Examiner's Answer fails to address nearly all of those reasons. Appellant therefore continues to believe that each group of claims is allowable for the reasons set forth in Appellant's Brief. The few additional arguments raised by the Examiner in the Examiner's Answer appear to be directed solely to the Group 1 claims and are addressed below.

First, the Examiner now argues that:

the stick-on tattoos used in the U.S. Patent to Lehmann appear to be the same as the tattoos used in the present invention, despite Lehmann's characterization to the contrary.

It is unclear how the Examiner can possibly make this assertion, and the Examiner provides no basis for it. For example, element 32b of Figure 8 and column 3, line 4 of Lehmann illustrate and describe his tattoo as including a layer of separate adhesive material, and even Examiner acknowledges that Lehmann's tattoos are in fact adhesive-backed. By contrast, the Group 1 claims recite that "the stick-on tattoo does not include separate adhesive material, and . . . is applied to the shoe without using

separate adhesive material." Thus, the tattoos used in Lehmann are clearly different than the tattoos in the present invention.

The Examiner also argues that:

if there is any doubt that these tattoos are different, there is nothing unobvious about using any of the well-known tattoos such as those in the instant specification, page 7, lines 1-3, instead of the simulated tattoos of Lehmann . . .

In response, Appellant notes that, even if Lehmann taught application of his tattoos to a shoe (and even the Examiner has acknowledged that it does not), there is simply no motivation in the applied art to replace Lehmann's tattoo with a tattoo that does not include separate adhesive material, as used in the present invention.

In this regard, and as noted in Appellant's Brief, adhesive-backed tattoos are known to adhere to a wide variety of surfaces. However, the types of materials to which tattoos used in the present invention will reliably adhere typically are much more limited. In fact, Appellant is unaware of any prior art that teaches application of such tattoos to any surface other than skin, and the Examiner has not cited any. Thus, Appellant believes that one of ordinary skill in the art would not have been motivated to replace Lehmann's tattoos with tattoos that do not include separate adhesive material and that are applied without using separate adhesive material. For these reasons, in addition to the other reasons set forth in Appellant's Brief, the Group 1 claims are believed to be allowable over the applied art.

Serial No.: 09/268,412

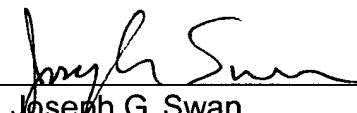
No additional grounds for rejection with respect to the other groups of claims have been set forth in the Examiner's Answer. Accordingly, such other groups of claims are believed to be allowable for the reasons set forth in Appellant's Brief.

Respectfully submitted,

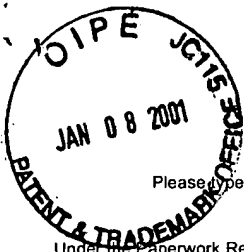
**MITCHELL, SILBERBERG & KNUPP LLP**

Dated: January 2, 2001

By

  
\_\_\_\_\_  
Joseph G. Swan  
Registration No. 41,338

**MITCHELL, SILBERBERG & KNUPP LLP**  
11377 West Olympic Boulevard  
Los Angeles, California 90064  
Telephone: (310) 312-2000  
Facsimile: (310) 312-3100



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<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>	<b>Application Number</b>	09/268,412
	<b>Filing Date</b>	March 15, 1999
	<b>First Named Inventor</b>	Albert J. Silvera
	<b>Group Art Unit</b>	3728
	<b>Examiner Name</b>	J. Mohandesi
<b>Total Number of Pages in This Submission</b>	<b>Attorney Docket Number</b>	31045-00007

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Joseph G. Swan MITCHELL, SILBERBERG & KNUPP LLP
Signature	<i>Joseph G. Swan</i> (41, 338)
Date	January 2, 2001

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